

acids. The Office Action impermissibly reads the term “non-peptide” apart from the rest of the claim. The claim, i.e., Claim 39, is not directed to any compound that is a non-peptide, but is directed to a non-peptide iodine containing intravenous contrast agent. Regardless of whether the specification provides basis for any compound that is a non-peptide, the specification does provide basis for a non-peptide iodine containing intravenous contrast agent. Similarly, the remaining terms, i.e., “non-polymer,” and “non-ionic,” should also not be read apart from the remainder of the claim in which they appear. In each case sufficient basis is present in the specification that one of ordinary skill in the art, upon reading the specification and the examples of contrast agents, would have recognized possession of the claimed classes, including those described by negative limitations.

The Office Action cites *Ex parte Grasselli*, 231 USPQ 393 (BPAI 1983), for the position that any negative limitation must have basis in the original disclosure. While that is correct; *Grasselli* does not require the literal support for negative limitations. As discussed in MPEP § 2173.05(i), the “lack of literal basis in the specification for a negative limitation may not be sufficient to establish a *prima facie* case for lack of descriptive support.” *Ex parte Parks*, 30 USPQ2d 1234, 1236 (BPAI 1993). “The mere absence of a positive recitation is not basis for an exclusion.” See MPEP § 2173.05(i). The test is whether one of ordinary skill in the art would have, upon reading the specification, recognized possession of the claimed classes, including those described by negative limitations. Applicants submit that in this case, basis for the claims, including the negative limitations, exists.

Reconsideration is respectfully requested.

#### **Rejection of Claim 18 Under 35 U.S.C. § 102(e)**

The Office Action alleges that claim 18 is anticipated by Galkin.

Galkin states the possibility of the use of contrast agents in mammography, but not that such was done. The reference does not teach or suggest the outcome of the alleged use of a contrast agent in the context of mammography. Furthermore, there is absolutely no example in the reference of such use. One of ordinary skill in the art at the date of the reference would have disregarded the statements regarding the use of contrast agents in mammography as no teaching is present which would guide one of ordinary skill in the art to perform the allegedly anticipating acts described in the language on column 4, lines 44-64.

Contrary to the allegations in the Office Action, one of ordinary skill in the art reading the reference patent would not have immediately envisaged a method of mammography using a contrast agent. In support of this position, applicants submit a Declaration by Prof. Bernd Hamm, MD, declaring that conventional mammography is not sensitive enough to detect X-ray contrast media in soft tissue, even at the highest doses and fastest injection rates approved for application in patients. For this reason, contrast medium administration was not used in conventionally mammography prior to 1999, until the advent of digital mammographic units, which allowed for the subtraction of pre-contrast and post-contrast images. Thus, the state of the art, even in light of general statements as in Galkin, suggested away from the use of contrast agents in mammography, such as projection mammography. Clearly, such general statements would not lead one to use the contrast agents recited in Applicants' claims in mammography.

#### **Rejection of Claims 18-45 Under 35 U.S.C. § 103**

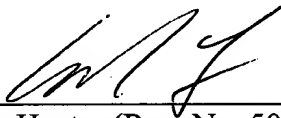
The claims are rejected over the combination of either of two primary references and six secondary references. However, these references, alone or in combination, do not provide motivation that would lead a skilled artisan toward the claimed invention.

The Office Action alleges that both Galkin (discussed above) and Nitecki teach the use of a contrast agent for mammography. Nitecki mentions mammography among a whole variety of applications, and mentions the use of contrast agents among a whole variety of possibilities, but only does so in a general sense. No specific teaching or suggestion, e.g., no example, is provided which would enable one of ordinary skill in the art to perform mammography with the use of a contrast agent. As discussed above, and supported by the Declaration by Prof. Bernd Hamm, MD., one of ordinary skill in the art prior to 1999, i.e., until the advent of digital mammographic units, knew that conventional mammography was not in general sensitive enough to detect X-ray contrast media in soft tissue, even at the highest doses and fastest injection rates approved for application in patients. Thus, even though the references make general statements, these statements should not be read in a vacuum, but in light of the state of the art. Based on the stated art, one of ordinary skill would not have been motivated to perform mammography with the use of contrast agents. As supported by the Declaration of Prof. Hamm, one of ordinary skill in the art, prior to 1999,

would have understood that the administration of contrast media provided no diagnostic value in their use in mammography while posing an inherent risk of adverse reactions in a patient. Thus, one of skill in the art would not have used a contrast agent in mammography prior to 1999 even in view of the disclosures of the two primary references. These references do not provide sufficient instruction to lead one of skill in the art to use a contrast agent for mammography in accordance with the claimed invention. The secondary references each only teach specific contrast agents without any motivation for their use in mammography. The claimed invention is therefore not obvious from the teachings of the cited references.

The Commissioner is hereby authorized to charge any fees associated with this response or credit any overpayment to Deposit Account No. 13-3402.

Respectfully submitted,



---

Csaba Henter (Reg. No. 50,908)  
Brion P. Heaney (Reg. No. 32,542)  
Attorney for Applicant(s)  
MILLEN, WHITE, ZELANO & BRANIGAN, P.C.  
Arlington Courthouse Plaza I, Suite 1400  
2200 Clarendon Boulevard  
Arlington, Virginia 22201  
(703) 812-5331 [Direct Dial]  
(703) 243-6410 [Facsimile]  
Internet Address: henter@mwzb.com

Filed: **February 10, 2003**

BPH/CH:imm:ack/K:\SCH\1653\REPLY FEB 2003.DOC